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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/067,987

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Jesse H. Gaytan

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EXAMINER

MOSS, KERI A

ART UNIT

PAPER NUMBER

1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/067,987

Applicant(s)

GAYTAN, JESSE H.

Examiner

Keri A. Moss

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006 and 19 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-47 is/are pending in the application.
- 4a) Of the above claim(s) 26-34 and 40-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-25 and 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed May 12, 2006 and Amendment filed on October 19, 2006 in response to the election restriction requirement has been acknowledged. Claims 1 and 3-47 are pending.

Response to Amendment

2. Restriction requirement has been maintained

New claims 40-47 are elected by original presentation.

New grounds of rejection under 35 U.S.C. 112, 2nd paragraph have been made.

Rejection of claims 1-11, 14-21, 24, 25, 30, 31, 35 & 36 has been maintained in light of applicant's arguments. New grounds of rejection of claims 12-13 and 22-23 in view of Lew has been made.

Provisional rejection of claims 26,27,30, 31, 32 and 33 under obviousness-type double patenting analysis have been maintained. New ODP rejection in view of Chan (USP 5298501) has been added.

Objection to claims 12, 13, 22, and 23 as dependent upon a rejected base claim but allowable if rewritten is withdrawn.

Election/Restrictions

3. Newly submitted claims **40-47** are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims required a drying step but the new claims do not.

Art Unit: 1743

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40-47 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Applicant's election with traverse of Group I claims 1, 3-25 and 35-39 in the reply filed on October 19, 2006 is acknowledged. The traversal is on the ground(s) that the new claims provide the missing link that ensures the product can be made by no other process than what is claimed. This is not found persuasive because the new claims are elected by original presentation and, notwithstanding, examiner is unconvinced that the product can be made by no other method. In addition, searching both the product and the process of making would require a burdensome search.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims **1, 3-13 and 35-38** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase in claim 1.a, "wherein active ingredient solids may emit volatile sulfur-based odors that are generally

Art Unit: 1743

objectionable to human perception" is indefinite. The claimed invention either does or does not emit volatile sulfur-based odors. In addition, the odors either are or are not objectionable to human perception (see also claim 14.a).

In claim 35.a, the active ingredient either does or does not emit odors.

All other like instances of indefiniteness are also rejected.

Claim Interpretation

7. Claims **24, 25, 37-39 and 44-47** are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. MPEP §2113. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP §2113.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims **1, 3-11, 14-21, 24-25 and 35-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cummings et al. (USP 6,337,323) in view of Neumann (USP 5,645,845).

Cummings teaches a chemically, stable insecticidally active pellet made by extrusion and having a low moisture content (up to .05% water) and at least about 95% of the active ingredient, acephate. See abstract and col. 4, lines 5-67. The insecticidal

Art Unit: 1743

pellet may also contain a binder, vinylpyrrolidone-vinyl acetate copolymer (col. 5, lines 19-24). Cummings teaches that the present formulation "reduces" the offensive odors associated with acephate usage (col. 6, lines 27-28). Moreover, the Cummings reference recognizes that those of skill in the insecticidal art would know that minor amounts of inert ingredients could be admixed with the active ingredient as long as the addition of the materials did not conflict with or adversely affect the basic characteristics of the pellets formed in accordance with the invention. At col. 20, lines 29-31, Cummings states "the pellets of the present invention can contain. . . reodorants." For the record, in the Kirk-Othmer Encyclopedia of Chemical Technology (1996), reodorants are defined as powerful pleasant smelling chemicals which are added to a formulation to mask unpleasant odors. In summary, Cummings provides motivation to combine the disclosed formulation with an agent that masks the odors of the product.

Cummings does not specifically disclose comprising the insecticidally-active formulation with terpenes or oxygenated derivative thereof. Neumann teaches an insecticidal formulation that teaches lemon oil, pinene, limonene and terpineol among perfumes that are useful in masking odor rendered from an insecticidal composition (col. 4, line 62; col. 5, lines 7-12). Neumann discloses using the perfumes in formulation with "at least one type of insecticide" (column 1 lines 4-10). Sulfur has been known and used as an insecticide since very early times and today sulfur is an active ingredient in approximately 300 registered pesticide products. Therefore, Neumann reasonably foresees using the perfumes with sulfur-containing insecticides. The perfumes of Neumann may also be used in formulation with insecticide and sulfur-

Art Unit: 1743

containing fungicides or bactericides (col. 5 lines 52-col. 6 line 3). Therefore, Neumann discloses using the terpene and citrus-scented perfumes with sulfur-containing, insecticidally active compounds. It would have been obvious to one of ordinary skill in the art to modify the sulfur-containing formulation of Cummings with the reodorants disclosed in Neumann because Neumann's disclosure teaches that these perfumes work effectively to cover up the odors of sulfur-containing insecticidal formulations.

10. Claims **12-13 and 22-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cummings and Neumann in view of Lew (EP 0 755 626 A1).

See Cummings and Neumann analysis supra.

Cummings and Neumann do not expressly disclose a binder comprising a polyalkylene oxide or a polyethylene oxide. Lew et al. teach that using a binder such as polyethylene oxide with an agrichemically effective solid formation improves its storage stability (column 3 lines 28-37). Since agrichemically effective solids are sensitive to hydrolysis during storage, increasing storage stability enables the agrichemically effective chemicals to be useful for longer periods of time and ensures their effectiveness after storage. Therefore, it would have been obvious for one of ordinary skill in the art to modify the product of Cummings and Neumann by adding a binder to gain the advantages of ensuring the effectiveness of the agrichemically effective solids after storage.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **26, 27, 30, 31, 32 and 33** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 14, 19, 33 and 34 of copending Application No. 10/508,407 in view of Chan et al (USP 5,464,623). Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a granulated insecticidal composition comprising phosphoroamido(di)thioate solid (acephate) and a binding agent. While the claims of Application 10/508,407 additionally comprise details on the size and particle distribution of the solid crystals, it would have been obvious to one of ordinary skill in the art to modify the composition of the instant application in view of Chan. Chan teaches that forming granules of phosphoroamido(di)thioate solids in the

Art Unit: 1743

shape of pellets with particular size and particle requirements eliminates dust problems and reduce surface area to weight ratio, which mitigates the odor problem (column 2 lines 38-44). Furthermore, it is well known that crystal size and particle distribution are result-effective variables and that altering the crystal size and the particle distribution has the well known result of determining the compactness and stability of the granules. Compactness and stability ensures the active formulation will not diminish. Therefore, it would have been obvious to one of ordinary skill in the art to modify the instant application with the size and particle distribution requirements of Chan in order to make a more stable solid compound and to further mitigate the odor problem associated with phosphoroamido(di)thioate solids.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Provisional obviousness-type double patenting rejections such as the present one apply to copending applications regardless of the order of filing. See MPEP § 804(B). A later filing date does not ensure a later patent date as numerous independent factors determine whether and when a patent is awarded.

Response to Arguments

12. Applicant's arguments filed May 12, 2006 have been fully considered but they are not persuasive.

13. Applicant argues that column 6 lines 27 and 28 does not support the position that Cummings discloses reducing the odors of acephate compositions. The paragraph as a

Art Unit: 1743

whole compares Cummings' pellet formulation with the prior art's powder formulations. The language in column 6 lines 27 and 28 specifically compares the odor of Cummings' pellets with the prior powder formulations. It is well known in the art that acephate has a strong unpleasant odor and since Cummings' formulation contains acephate, acephate is a cause of the referenced odor. In absence of evidence to the contrary, Cummings teaches a formulation that reduces the offensive odors associated with acephate usage.

14. Applicant disagreed with the definition of reodorant given by Examiner. The Kirk-Othmer Encyclopedia of Chemical Technology, Odor Modification, Section 4.1, Masking demonstrates that the term "reodorant" is synonymous with "masking odors."

Furthermore, applicant has not proven that Toximul 3406F is not a powerful pleasant smelling chemical. Cumming's examples of reodorant systems are not restrictive and do not limit the broadness of it's teaching of the use of alternative reodorants in its formulation.

15. In response to applicant's arguments that Neumann does not provide motivation to use perfumes for sulfur-containing compounds, Examiner notes that Neumann discloses using the perfumes in formulation with "at least one type of insecticide" (column 1 lines 4-10). Sulfur has been known and used as an insecticide since very early times and today sulfur is an active ingredient in approximately 300 registered pesticide products. Therefore, Neumann reasonably foresees using the perfumes with sulfur-containing insecticides. The perfumes of Neumann may also be used in

Art Unit: 1743

formulation with insecticide and sulfur-containing fungicides or bactericides (col. 5 lines 52-col. 6 line 3). Therefore, Neumann discloses using the terpene and citrus-scented perfumes with sulfur-containing, insecticidally active compounds.

16. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

17. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cummings teaches using masking agents in his insecticidal sulfur-containing pellet composition (col. 20 lines 29-31). Neumann teaches that terpenes are among perfumes that are useful in masking odor in an insecticidal composition with sulfur-containing compounds (col. 4, line 62; col. 5, lines 7-12; col. 5 lines 52-col. 6 line 3). Therefore, it would have been obvious to use the terpene perfumes of Neumann as the disclosed reodorants in

Art Unit: 1743

the composition taught by Cummings with reasonable likelihood of success that the terpenes and oxygenated derivatives would mask the odors of sulfur-containing compounds.

18. Applicant argues that there is no expectation of success. However, in the prior art, each element works for its intended purpose, which would indicate a reasonable likelihood of success that each would work in combination. MPEP § 2143.02.

19. Finally, Applicant argues that the obviousness-type double patenting rejection should be withdrawn because the copending application has a later effective filing date than the instant application. The MPEP does not distinguish between filing dates in double patenting analysis. MPEP § 804(B). Further, applicant's argument is not convincing since innumerable applications have become patents earlier than other applications having earlier filing dates.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keri A. Moss whose telephone number is 571-272-8267. The examiner can normally be reached on 9-5:30.

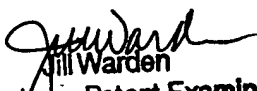
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keri A. Moss
Examiner
Art Unit 1743

KAM 1/4/07


Jill Warden
Supervisory Patent Examiner
Technology Center 1700